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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,100	08/18/2003	Ken Barnard	13154.005	3341

42922 7590 02/21/2006

WHITAKER, CHALK, SWINDLE & SAWYER, LLP  
3500 CITY CENTER TOWER II  
301 COMMERCE STREET  
FORT WORTH, TX 76102-4186

EXAMINER

CHAPMAN, JEANETTE E

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/643,100	BARNARD, KEN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Chapman E. Jeanette	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/18/03</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to the combination garage door and window frame, classified in class 52, subclass 204.5.
- II. Claims 11-18, drawn to a method of installing a window assembly, classified in class 52, subclass 745.15.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the method of installing can be used with a product or apparatus combination having additional or slightly variable structural elements than those claimed. See cited prior art below...

Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the method of installing can be used with a product or apparatus having additional or slightly variable structural elements than those claimed. See cited prior art below..

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr Gunter Charles on 2/1/06 a provisional election was made without traverse to prosecute the invention of Group II, claims 11-18. Affirmation of this election must be made by applicant in replying to this Office action. Claim 1-10 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 12, 14-18 are objected to for the following reasons: Claims 12 and 14-18 do not include any positive method limitations

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 11 is rejected under 35 U.S.C. 102(e) as being anticipated by Herbst (5894706).

Herbst et al discloses a method of installing a window assembly within a door having front and rear exposed surfaces and at least one opening provided therein. The method comprising:

- Providing a front window frame member 20 formed in one piece of synthetic polymeric material (polystyrene, polypropylene), the front window frame 20 having a central opening and a periphery sized to circumscribe the window opening from the front exposed surface; see figures 1 and 3
- Providing a rear window frame member 21 formed in one piece of synthetic polymeric material (polystyrene, polypropylene), the front window frame 21 having a central opening and a periphery sized to circumscribe the window opening from the front exposed surface; see figures 1 and 3
- Providing snap fit engagement elements about the peripheries of the front and rear frame which snap in a mating fashion; see figure 8A and accompanying text
- Installing the front window frame 20 within the door opening on the front exposed surface; see figure 1
- Locating a transparent pane 15 within the central opening of the front window frame
- Installing the rear frame window member 21 on the opposite, rear exposed surface of the door opening to thereby mount the frame members 20/21 within the window/door opening with the transparent pane 15 sandwiched between
- Pressing the inner and outer window frame members together in order to engage the snap fit engagement elements; column 4, lines 1-35

- Column 4, lines 29-35," alternatives to the assembly include a one piece door or an assembly with a snap fit sonic weld, a mechanical attachment or compression fit.

The type of window assembly is not critical to the method. The claimed limitations are not limited to a garage door. The claims are directed to a method of using/ making not the article. One of ordinary skill in the art would have appreciated that the method of making and using may be applied to most any snap fit window frame using a hand tool to assemble and disassemble the frame parts may be applied. Nothing specifically critical has been recited to limit the structure to only be used with a garage door/door opening

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herbst in view of Beaudoin et al (6931810).

Herbst lacks the access opening and the hand tool to separate the frame members and remove the members from the window opening.

Beaudoin et al discloses: (see column 7 lines 1-35)

- using a hand tool 76 to disengage snap fit or locking elements 66
- separating the window frame elements 28 and 52

- removing the existing transparent pane 22
- installing a new transparent pane
- engaging the window frame members 28 within the opening

The type of window assembly is not critical to the method. The claimed limitations are not limited to a garage door. The claims are directed to a method of using/ making not the article. One of ordinary skill in the art would have appreciated that the method of making and using may be applied to most any snap fit window frame using a hand tool to assemble and disassemble the frame parts may be applied. Nothing specifically critical has been recited to limit the structure to only be used with a garage door opening

In view of the above it would have been obvious to include and access opening for hand tool used to separate frame member parts from the panel and replace the pane with another as taught by Beaudoin et al in order to provide a means to readily replace a cracked pane.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herbst in view of Jennen et al (4079529). Jennen et al discloses inner and outer frame members 2 and 1 which mate by a snap fit. The window frame is constructed of injected molded plastic. See column 2, lines 61-63. The engagement elements are tabs 3/6-8 provided on one respective frame 2 for engaging aligned lips provided on the other respective frame 1. See figure 7.

In view of the suggestion of Herbst, column 4 lines 29-35, it would have been obvious to provide more of a snap fit arrangement for the frame members of injection molded

material in order that the same remain securely attached as suggested by Herbst and taught also by Jennen et al.

*Because it is unclear as to how the claims will be amended if at all, the indicated allowability of claims 15-18 has been held in abeyance until claims 15-18 are amended to include positive method steps.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chapman E. Jeanette whose telephone number is 571-272-6841. The examiner can normally be reached on Mon.-thursday, 8:30-6:00, every fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Friedman Carl can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jec

  
Jeanette Chapman  
Primary Examiner